P17494                                                    PATENT

# REMARKS

Claims 1-24 stand rejected and are pending in the application. Claims 2 and 10 have been canceled herein without prejudice to the filing of continuations and divisionals, and Claims 1, 3, 9, 11 and 17 have been amended herein to further clarify the scope of the claimed invention. Applicants respectfully request reconsideration of pending Claims 1, 3-9, 11-24 in light of the amendments and remarks herein.

### *35 U.S.C. §103*

Claims 1-6, 9-14 and 17-22 stand rejected under 35 U.S.C. §103 as being unpatentable over the combination of U.S. Patent No. 6,321,090 B1 ("Soliman") in view of U.S. Publication No. 2004264414 A1 ("Dorenbosch"). Additionally, Claims 7, 15 and 23 stand rejected under 35 U.S.C. §103 as being unpatentable over the combination of Soliman in view of Dorenbosch and in further view of U.S. Publication No. 2004/0037260 ("Kakemizu"). And finally, Claims 8, 16 and 24 stand rejected under 35 U.S.C. §103 as being unpatentable over the combination of Soliman in view of Dorenbosch and in further view of U.S. Publication No. 2006/0018296 A1 ("Mukaoka"). Applicants respectfully traverse the Examiner's rejections.

Soliman describes a "mobile communicationi system with position detection to facilitate hard handoff" (Soliman, Title) while Dorenbosch teaches "fast handover through proactive registration" (Dorenbosch, Title). The Examiner concedes that Soliman does not explicitly disclose the element of "executing the location module to determine whether the mobile node is on an intranet network". The Examiner suggests, however, that Dorenbosch teaches this element and that it would have been obvious to one of ordinary skill in the art to combine the teachings of Soliman with Dorenbosch to do so. Applicants respectfully disagree.

Applicants respectfully submit that the combination of Soliman and Dorenbosch does not render Claims 1-30 unpatentable. First and foremost, Applicants submit that Soliman does not teach the elements of the claims suggested by the Examiner. As amended, independent Claims 1, 9 and 17 include the elements of accessing static information from a configuration database, accessing dynamic information from the

8

PATENT

mobile node when the mobile node starts up, selecting a location module based on the static and dynamic information and executing the location module to determine whether the mobile node is on an intranet or an external network separated from the intranet by a corporate demilitarized zone ("DMZ"). Soliman does not teach or suggest various elements. For example, Soliman does not teach or suggest the use of static and dynamic information for a mobile node, as claimed. The section of Soliman highlighted by the Examiner (Soliman, Col. 7, lines 1-10, 62-67 and Col. 8, lines 45-57) to allegedly show these elements do not, in fact, make any mention of static or dynamic information pertaining to the *mobile node*. Instead, these sections of Soliman appear to describe how the mobile unit selects "hand off" regions and how information about these regions is determined. Thus, for example. Table 1 highlighted by the Examiner clearly states that it describes a "sample position database table", where the position database maintains information corresponding to the *locations of the current hard handoff regions* (Soliman, Col. 8, lines 46-48). Applicants respectfully submit that these sections of Soliman are irrelevant to the elements of Claims 1, 9 and 17 which clearly articulate that the static and dynamic information pertain to the *mobile node*.

Additionally, the Examiner concedes that Soliman does not explicitly teach at least one significant element of the claimed invention, namely executing the location module to determine whether the mobile node is on an intranet network, but suggests that Dorenbosch teaches this element. Applicants agree with the Examiner that Soliman does not teach or suggest this element, but strongly disagree that Dorenbosch teaches or suggests the element and may be combined in Soliman in the manner suggested.

First, with respect to Dorenbosch, Applicants respectfully submit that the Examiner's rejections of Claims 1-24 are facially deficient because the Examiner has not established a prima facie case of unpatentability. As is well-established, in order to establish a prima facie case of unpatentability under 35 U.S.C. § 103, the cited prior art combination must disclose every limitation of the claims being rejected. Therefore, if even one claim element or limitation is not disclosed by the combination of references, a prima facie case is not established. Additionally, as the Federal Circuit has noted,

"As adapted to *ex parte* procedure, Graham [v. John Deere Co.] is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce

9

the <u>factual basis for its rejection</u> of an application under sections 102 and 103." (emphasis added)

*In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The Examiner thus has the burden of producing a factual basis for his rejection and for establishing unpatentability by identifying how each recited claim element is allegedly disclosed by the combination of the cited reference. Applicants respectfully submit that the Examiner has failed to establish such a *prima facie* case and has merely provided bare allegations that the combination of these references renders the claims unpatentable. Specifically, with respect to the element allegedly taught by Dorenbosch, the Examiner makes no attempt to identify the factual basis for the allegation, but instead points to 14 long paragraphs of Dorenbosch and simply states these 14 paragraphs teach or suggest the element. Applicants respectfully submit that this general conclusary allegation is woefully inadequate to establish a prima facie case of unpatentability. Applicants therefore respectfully submit that the rejection of Claims 1-24 based on any combination of Soliman with Dorenbosch (with or without other referenes) is facially deficient for at least this reason.

Even assuming arguendo the Examiner had met his burden of proof, the sections of Dorenbosch highlighted by the Examiner (Paragraphs 17-30), do not appear to be relevant to the claimed elements. Applicants' own reading of Dorenbosch indicates that similar to Soliman, Dorenbosch describes a scheme for a fast handover from one access point to another by proactively registering with new access points (Dorenbosch, Paragraph 17). There is nothing in Dorenbosch, however, that describes the element alleged by the Examiner, namely determining whether the mobile node is on an internal network or an external network separated from the internal network by a DMZ. As defined in the specification in Paragraphs 13 and 14, an external network is a network that is separated from an internal (or corporate) network by a DMZ. There is no description of any such "internal" or "external" network in Dorenbosch. It would be impossible, therefore, for Dorenbosch to teach or suggest the claimed element. Soliman also does not teach or suggest this element, as conceded by the Examiner. As a result, Applicants respectfully submit that the combination of Soliman and Dorenbosch does not

10

P17494                                                        PATENT

## CONCLUSION

Based on the foregoing, Applicants respectfully submit that the applicable objections and rejections have been overcome and that pending Claims 1, 3-9, 11-24 are now in condition for allowance.  Applicants therefore respectfully request an early issuance of a Notice of Allowance in this case.  If the Examiner has any questions, the Examiner is invited to contact the undersigned at (714) 669-1261.

If there are any additional charges, please charge Deposit Account No. 50-0221.

Respectfully submitted,

Dated: June 6, 2006                    /Sharmini N. Green/
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12